Attorney Docket No. AUS920010328US1
Serial No. 09/888,452
Response to Office Action dated 12/03/2003

A. REMARKS

1. Claim Rejections – 35 USC §103

The Examiner rejected claims 1-26 under §103(a) as being unpatentable over the Card reference (www.javaworld.com/javaworld/jw-03-1998/jw-03-javadev_p.html). The Examiner stated that the claims were obvious in light of the Card reference.

The Examiner has failed to make out a *prima facie* case of obviousness with respect to the card reference. The requirements for a *prima facie* case of obviousness are well defined:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. MPEP §706.02(j) citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis ours).

With respect to the Card reference, the Examiner has not met any one, let alone all three, of the prongs of the obviousness test. Most importantly, the Card reference does not teach or suggest all of the claim limitations. Claims 1-26 recite the limitation of three distinct numbers, a basic number, a primary number, and a secondary number, for multiple parties to access consumer data. Claim 1 recites the limitation "wherein a consumer uses a basic number and a primary number to access an account in the data base and the consumer can modify an account data in the data base; and wherein a merchant uses the primary number and a secondary number to access the account and the merchant is prohibited from modifying the account data in the data base." The Card reference only discloses the use of a single PIN in one sentence of the reference: "Access to the wallet is authenticated by an owner PIN." *See* the Card reference, p. 7. The Card

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reference does not disclose the use of any other numbers in accessing consumer data on the Java Card. Because the Card reference does not teach or suggest all of the claim limitations, the Examiner has not made out a *prima facie* case of obviousness and the claims should be allowed over the prior art.

Likewise, claim 14 recites the limitation "A data base that may be accessed by a consumer having a basic number and a primary number and by any party to whom the consumer provides the primary number and a secondary number; and wherein the primary number and secondary number are specific to each individual party to whom the consumer provides the primary number and the secondary number." Thus, claim 14 contains the limitation of three distinct numbers: a basic number, a primary number, and a secondary number. The Examiner states "MasterCard and Visa ... support smart card systems and applications – thus, the Java Card works with a machine that is connected to a computer that has financial data, such as a credit card." *See* Office Action dated 12/03/2003, p.5 (ellipses his). Neither the Office Action nor the Card reference discloses the use of any numbers in accessing consumer data on the Java Card, much less three distinct numbers. Because the Card reference does not teach or suggest all of the claim limitations, the Examiner has not made out a *prima facie* case of obviousness and the claims should be allowed over the prior art.

Claim 18 recites the limitation "wherein the primary number and the secondary number allow access to the data base; wherein the primary number and the secondary number prohibit modification to the data base; and wherein the primary number and secondary number are specific to each individual person to whom the consumer provides the primary number and the secondary number." Thus, claim 18 contains the limitation of two distinct numbers: a primary number and a secondary number. The Examiner states "MasterCard and Visa ... support smart

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card systems and applications – thus, the Java Card works with a machine that is connected to a computer that has financial data, such as a credit card." *See* Office Action dated 12/03/2003, p.5 (ellipses his). Neither the Office Action nor the Card reference discloses the use of any numbers in accessing consumer data on the Java Card, much less two distinct numbers. Because the Card reference does not teach or suggest all of the claim limitations, the Examiner has not made out a *prima facie* case of obviousness and the claims should be allowed over the prior art.

Similarly, claim 23 recites the limitation "wherein the storage medium, so configured by the computer program, allows access to, but not modification of, the data base upon receipt of a correct combination of a primary and a secondary number." The Examiner states "MasterCard and Visa ... support smart card systems and applications – thus, the Java Card works with a machine that is connected to a computer that has financial data, such as a credit card." *See* Office Action dated 12/03/2003, p.5 (ellipses his). Neither the Office Action nor the Card reference discloses the use of any numbers in accessing consumer data on the Java Card, much less two distinct numbers. Because the Card reference does not teach or suggest all of the claim limitations, the Examiner has not made out a *prima facie* case of obviousness and the claims should be allowed over the prior art.

Furthermore, the Examiner has not identified any suggestion or motivation in the Card reference or the knowledge of a person of ordinary skill in the art that would lead a person of ordinary skill in the art to modify the Card reference to obtain the claimed invention. The Examiner completely failed to address this issue with respect to claims 1-26. Moreover, the Examiner has not identified any portion of the Card reference that would indicate a reasonable expectation of success in using three numbers to access the consumer's data. The Examiner also

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failed to address this issue with respect to claims 1-26. Consequently, claims 1-26 should be

allowed over the cited prior art.

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For the foregoing reasons, the Applicant submits that the claims of the present application

are not fairly taught by any of the references of record, taken either alone or in combination.

Therefore, allowance of the present application is in order, and is requested.

Respectfully submitted,

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Date

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